No. 03-314

Supreme Court, U.S.
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In The

Supreme Court of the United States

RICHARD SATAVA, an individual;
SATAVA ART GLASS, a sole proprietorship,

Petitioners,

v.

CHRISTOPHER LOWRY, an individual;
CHRISTOPHER RICHARDS, an individual;
MAKAWAO GLASSWORKS, LLC, dba
HOT ISLAND GLASS,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF IN OPPOSITION

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INTRODUCTION

Defendants/Respondents Christopher Lowry, an individual, Christopher Richards, an individual and Makawao Glassworks LLC, d/b/a Hot Island Glass, submit this Opposition Brief in response to the Petition for a Writ of Certiorari filed by Plaintiff/Petitioner Richard Satava, an individual, d/b/a Satava Art Glass.

REASONS FOR DENYING THE PETITION

Overview

Petitioner asserts two reasons why this Court should review the decision by the Ninth Circuit. Firstly, he contends that the Ninth Circuit's decision conflicts with the holdings of this Court and several circuit courts. Secondly, he argues that the concept of a "thin" copyright, set forth in *Feist Pubs Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), and several circuit cases, should not be applied to "art". Petitioner is incorrect when he asserts that the Ninth Circuit's decision conflicts with cases from the Ninth and other circuits. The concept of "thin" copyright protection is a part of a law of the Ninth Circuit and the other Circuits referred to by Petitioner. The Ninth Circuit did not reshape substantive law when it reversed the district court's grant of a Preliminary Injunction. Rather, it applied the law of this Court and the Ninth and other Circuits to the record facts. It was Petitioner who was asking the Ninth Circuit to reshape substantive law by extending copyright protection to elements that are not original to Petitioner. *Feist Pubs v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) applies in this case. *Feist* is not limited to telephone directories, but applies to discoverable

facts in any type of work. There was no improper fact finding by the Ninth Circuit. The Ninth Circuit did not misread and/or rewrite facts in a way that conflicts with the record. In the Ninth Circuit decision, the Ninth Circuit referred to substantial and significant parts of the record that support its conclusions.

Factual Background

Petitioner and Respondents both make and sell glass-in-glass jellyfish sculptures which are inspired by real life jellyfish. The real life jellyfish in question are basically characterized by a bell at its top and tentacles depending from the bell. At times this jellyfish swims upwardly in a vertical orientation. The glass-in-glass art medium is well established and involves a basic process. A glass art object is formed on the end of a rod or "pontil". Then, the end of the "pontil" and the glass art object are dipped into molten glass to pick up more glass to form a glass shroud around the glass object. The shroud shape in question (a "gather" shape) is not original with Petitioner but rather is a common shape that results when the glass art object inside the shroud is taller than it is wide and is wider at its top than at its bottom. This "gather" shaped shroud is an economical shape because it requires less time, skill and materials than do other shroud shapes.

Petitioner and Respondents' jellyfish sculptures both show a jellyfish in a vertical orientation, with its bell at the top and its tentacles depending from the bell. Both are encased in a clear glass shroud so that observers can look into the shroud and see the jellyfish. There are substantial

differences, however, between Petitioner and Respondents' jellyfish involving shape, color and arrangement of the bell and tentacles of the jellyfish.

The Ninth Circuit Acknowledged That Satava's Jellyfish Sculptures Are Copyrightable

In its decision, the Ninth Circuit stated:

> **We do not mean to suggest that Satava has added nothing copyrightable to his jellyfish sculptures. He had made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes' bells. To the extent that these and other artistic choices were not governed by jellyfish physiology or the glass-in-glass medium, they are original elements that Satava may theoretically protect through copyright law. Satava's copyright on these original elements (or their combination) is "thin", however, comprising no more than the original contribution to ideas already in the public domain. Stated in another way, Satava may prevent others from copying the original features he contributed, but he may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculpturers.**

Satava v. Lowry, 323 F.3d at 812.

The Ninth Circuit Decision Does Not Conflict With *Bleistein*

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) involved pictorial illustrations that were part of circus advertisements. The lower courts had ruled that the pictorial illustrations were not covered by the copyright laws. The Sixth Circuit stated:

> **What we hold is this: that if a chromo, lithograph, or other print, engraving, or picture has no other use than that of a mere advertisement, and no value aside from this function, it would not be promotive of the useful arts, within the meaning of the constitutional provision, to protect the 'author' in the exclusive use thereof, and the copyright statute should not be construed as including such a publication, if any other construction is admissible.**

Later in its decision the Sixth Circuit further stated with respect to the pictorial illustration that:

> **It must have some connection with the fine arts to give it intrinsic value – The jury could not reasonably have found merit or value aside from the purely business object of advertising a show, and the instruction to find for the defendant was not error.**

On review, this Court rejected this view and stated:

> **A picture is none the less a picture, and none the less a subject of copyright, that it is used for an advertisement.**

The issue in this case is not the issue that was before the court in *Bleistein*. In its decision, the Ninth Circuit stated:

> **Satava may prevent others from copying the original features he contributed, but he may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculptures.**

Satava v. Lowry, 323 F.3d at 812. Quite clearly, the Ninth Circuit decision does not conflict with this Court's holding in *Bleistein*.

The Ninth Circuit Decision Is Consistent With Ninth Circuit Precedent

The Ninth Circuit cited several Ninth Circuit cases in support of its holding, including *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) ("When we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with . . . a 'thin' copyright, which protects against almost virtually identical copying."); and *Apple Computer, Inc. v. Microsoft Corporation*, 35 F.3d 1435, 1439 (9th Cir. 1994) ("When the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity").

The Ninth Circuit stated:

> **We do not hold that realistic depictions of live animals cannot be protected by copyright. In fact, we have held to the contrary. See *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1061 [216 USPQ 376] (9th Cir. 1991). We recognize, however, that the scope**

> **of copyright protection in such works is narrow. See *Herbert Rosenthal Jewelry, Corp. v. Kalpakian*, 446 F.2d 738, 741 [170 USPQ 557](9th Cir. 1971) ("Any inference of copying based upon similar appearance lost much of its strength because both [works] were lifelike representations of a natural creature"). Nature gives us ideas of animals in their natural surroundings: an eagle with talons extended to snare a mouse; a grizzly bear clutching a salmon between its teeth; a butterfly emerging from its cocoon; a wolf howling at the full moon; a jellyfish swimming through tropical waters. These ideas, first expressed by nature, are the common heritage of humankind, and no artist may use copyright law to prevent others from depicting them.**

Satava, 323 F.3d at 812.

The Ninth Circuit based its decision on *Ets-Hokin, Kamar* and *Herbert Rosenthal* (1971); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109-10 (9th Cir. 1970); *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983); and *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) ("No copyright protection may be afforded to the idea of producing stuffed dinosaur toys or to elements of expression that necessarily follow from the idea of such dolls." "Appellants therefore may place no reliance upon any similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of stuffed animals.")

The Ninth Circuit further stated:

> **An artist may, however, protect the original expression he or she contributes to these ideas. An artist may vary the pose, attitude,**

> **gesture, muscle structure, facial expression, coat or texture of animal. An artist may vary the background, lighting or perspective. Such variations, *if original*, may earn copyright protection. Because Satava's jellyfish sculptures contain few variations of this type, the scope of his copyright is narrow.** (emphasis added)

Satava, 323 F.3d at 813.

In *Kamar*, the Ninth Circuit made reference to an earlier case in which a district court had stated:

> **"[T]he mere fact that plaintiff used a matter in the public domain does not in and of itself preclude a finding of originality, since plaintiff may have added unique features to the matter so as to render it copyrightable." *Kamar*, 657 F.2d at 1061.**

The *Kamar* court later stated:

> **That which was original, and copyrightable, was the special texture and design of the stuffed animals.**

Id., 657 F.2d at 1062.

A similar finding was made by the Ninth Circuit in its decision:

> **[Satava] made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes' bells.**

Satava, 323 F.3d at 312.

The Ninth Circuit decision is also consistent with *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 766 (9th Cir. 2003)

("[T]he range of protectable expression is constrained by both the subject matter idea of the photograph and the conventions of the commercial product shot.") Here, the "subject matter idea" involves jellyfish in a natural position and the "conventions" involve common features of the glass-in-glass art medium.

The Ninth Circuit Decision Does Not Conflict With Decisions From Other Circuits

Petitioner cites four cases from other Circuits: *Knitwaves v. Lollytogs Ltd.*, 71 F.3d 996 (2nd Cir. 1995); *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600 (1st Cir. 1988); *Rushton v. Vitale*, 218 F.2d 434 (2nd Cir. 1955); and *Masquerade Novelty v. Unique Industries, Inc.*, 912 F.2d 663 (3rd Cir. 1990). These cases do not support Petitioner's arguments.

Knitwaves involves designs on children's sweaters. One of the sweaters included a squirrel and leaves on a multi-panel front. In its decision, the Second Circuit Court stated that what is protectable is "the author's original contributions". It made reference to *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 19 USPQ2d 1418 (2nd Cir. 1991) in which the Court had narrowed the scope of copyright because an ornate background was in the public domain and thus was not a part of the original contribution by the copyright owner.

The First Circuit Court stated in *Concrete Machinery* that an artist can claim to own only an original manner of expressing ideas, not the ideas themselves. A copyright owner cannot succeed with an infringement action simply because the accused infringer also produced concrete statutes of deer, swans or donkeys. The copyright owner

must demonstrate that the accused infringer's works are substantially similar to the copyright owner's "original expression". In support of its decision, the court cited *Mazer v. Stein*, 347 U.S. 201 (1954) and *Herbert Rosenthal* (1971). Then the *Concrete Machinery* court stated:

> **As an example in this case before us, appellant has a copyright in a design of concrete "life-sized deer". The idea behind this particular expression can be briefly described as a "realistic-looking deer". Appellant cannot prohibit others from appropriating this idea; it can, however, prohibit any actual copying of its own version of a "realistic-looking concrete deer". Yet, it has a problem of proof: because the statue is a detailed replica of a real deer, the deer, *in essence, supplied most of the features which any subsequent artist can also take from the real deer.*** (emphasis added)

Id., 843 F.2d at 607. Here, the general jellyfish features (bell, tentacles, swimming upwardly) are supplied by the jellyfish.

The *Concrete Machinery* court further stated that on rehearing "the [district] court should 'dissect' the works to identify those aspects which Concrete likely will be able to show are protected expression and were copied by Classics." *Id.*, 843 F.2d at 611.

Rushton involved a doll in the form of a chimpanzee. The Second Circuit Court made reference to *Mazer* and stated that an author is entitled to copyright protection if he contributed something that was recognizably his own. The Court stated that "[o]riginality in this context means little more than a prohibition of actual copying." 218 F.2d

at 435. Without describing it, the Court concluded that the chimpanzee included a contribution by the author that the defendant had copied.

Masquerade involved copyrighted nose masks. The defendant contended that the masks were not entitled to copyright protection because they were "useful articles" under § 101. The Third Circuit Court rejected this argument and remanded the case for further proceedings on the issue of infringement. It further stated, "[w]e acknowledge that Masquerade may have difficulty in demonstrating infringement on remand, given that their nose masks and the nose masks of Unique are relatively straightforward representations of animal noses" (912 F.2d at 671) and referred to *Mazer* and *Herbert Rosenthal Jewelry Corp. v. Honora J. Co.*, 509 F.2d 64 (2nd Cir. 1974). In the latter case, no infringement was found because the similarities between the plaintiff's and defendant's pins came primarily from the general shape of turtles, referring to *Herbert Rosenthal* (1971). Accordingly, with respect to "art" objects, the First, Second, Third and Ninth Circuit Courts have all "narrowed" copyright protection to original contributions of the copyright owner.

The Ninth Circuit Decision Did Not Overlook Other Precedent

In *Metcalf v. Bochco*, 294 F.3d 1069 (9th Cir. 2002), the Ninth Circuit stated that

> **[P]rotectable expression includes the specific details of an author's rendering of ideas, or the 'actual concrete elements that make up the total sequence of events and the relationships between the major characters' ... Here, the similarities proffered**

> **by the Metcalfs are not protectable when considered individually; they are either too generic or constitute 'scenes a faire' . . . one cannot copyright the idea of an idealistic young professional choosing between financial and emotional reward, or of love triangles among young professionals that eventually become strained, or of political forces interfering with private action.**

Id., 294 F.3d at 1074. This holding by the *Metcalf* court is consistent with the Ninth Circuit's holding in this case that the selection of the clear glass and oblong shroud, bright colors, proportion, vertical orientation and a stereotype jellyfish form, considered together, lacks the quantum of originality needed to merit copyright protection.

In *Cavalier v. Random House*, 297 F.3d 815 (9th Cir. 2002), the Ninth Circuit warned that a court must take care to inquire only whether "the protectable elements, standing alone, are substantially similar". It stated that "a court must filter out and disregard the non-protectable elements in making its substantial similarity determination." Here, in its decision, the Ninth Circuit has in effect provided instructions to the district court to, on remand, "filter out and disregard the non-protectable elements in making its substantial similarity determination". The Ninth Circuit's decision is in complete harmony with *Cavalier*.

Petitioner misstates the holdings in *Kamar*, *Cavalier*, *Knitwaves* and *Metcalf*. The *Kamar* court held that infringement must be based on "substantial similarity in the expression of the ideas". It remanded the case to the trial court for a specific decision upon the validity of the copyright and a reexamination of the question of infringement.

Cavalier and *Metcalf* both held that "a court must filter out and disregard the non-protectable elements in making its substantial similarity determination". Here, that is what the Ninth Circuit did in its decision.

Feist Has Application To All Works

The *Feist* court stated that the essential ingredient present in creations, but absent in facts, is originality, "the *sine qua non* of copyright". *Feist*, 499 U.S. at 345. Here, the Ninth Circuit correctly treated the standard jellyfish features of a bell at the top and tentacles depending from the bell and the standard shroud shape of bulbous at the top and tapering toward the bottom as being "discoverable facts". These features were not the product of Petitioner's creativity. They are non-protectable elements that a court must filter out and disregard in making its substantial similarity determination.

The Ninth Circuit Did Not Overlook And/Or Distort Facts In The Record

It is undisputable, clear glass and oblong shrouds are commonplace aspects of the glass-in-glass medium. Clear glass sculptures are presented throughout ER 83-ER 143. For example, Item 752 on ER 89 is described on ER 88: "colorless glass encloses red lily flower". Several bright colored objects in clear glass are displayed on ER 103. Clear crystal is shown on ER 109 to enclose brightly colored objects. Clear glass shrouds surrounding colorful objects are shown on ER 115-ER 118. ER 127 defines "crystal" as being "a high-quality clear, colorless glass". It is undisputable, the "gather" shaped shroud is a common shroud shape in the "public domain". This is unprotectable

"discoverable fact", not "protectable expression". See, for example, Item 46 on ER 87, Item 83 on ER 91, Item 709 on ER 93 and Item 254 on ER 97. See also the items shown at the lower right corner on ER 117.

Nature provides a jellyfish with bright colors, with a bell at its top and tentacles depending from the bell, which are typical elements of jellyfish physiology. These facts are established by "A Guide to the World of Jellyfish". See ER 144-ER 163, and in particular ER 150. That guide states that jellyfish swim upwardly in the water. See page 11 of ER 156. It is not even original in the glass art to depict a jellyfish in an upright or vertical position. See ER 244-ER 250.

Recognizing the physiognomy of jellyfish and the nature of the glass-in-glass art medium, both of which are clearly set forth in easy to read publications, does not constitute overlooking and/or distorting facts in the record. Very clearly, these "facts" are in the record and they provide a firm basis for this Court's application of the controlling law to the "facts".

Aliotti Is Of Primary Importance

The *Aliotti* court stated that "[a]ppellants therefore may place no reliance upon any similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of stuffed animals". *Id.*, 831 F.2d at 901. Here, the Ninth Circuit states that Petitioner could place no reliance upon any similarity in expression resulting from either the physiognomy of jellyfish or from the nature of glass-in-glass art objects. The *Aliotti* court instructed that "a court must filter out and disregard the non-protectable elements in making its substantial similarity

determination". The record clearly establishes that many jellyfish have bells at their tops and tentacles depending from their bells and jellyfish swim vertically upwardly at times. The record also clearly shows that it is very commonplace to make a shroud from clear glass. The basic object of glass-in-glass art is to provide a sculpture inside of a shroud that can be easily seen and appreciated by persons looking through the shroud. The Ninth Circuit recognized that Petitioner's jellyfish included protectable features, such as the specific bell and tentacle shapes and color hues.

In its decision, the Ninth Circuit reviewed the underlying issue of law and then considered the record facts with respect to that law. As pointed out above, it followed the law of the Ninth Circuit when it held that Petitioner may not place any reliance upon any similarity in expression resulting from either the physiognomy of jellyfish or from the nature of the glass-in-glass art medium. The record facts clearly establish that a common form of jellyfish has a bell at its top and tentacles depending from the bell and jellyfish swim vertically upwardly as well as in other directions. The Ninth Circuit referred to the record when it stated that the use of clear glass and the use of a shroud that is rounded at its top and tapers towards its bottom are not creations of Satava, but rather are common features in the glass-in-glass art medium free for all to use. The record facts include publications showing the physiognomy of jellyfish and the common shroud shapes and materials used in the glass-in-glass art medium. It is clear, that the district court's look at the record facts had been done in light of an erroneous view of the applicable law.

The Line Between Protectable And Unprotectable Features Has Been Established By The Ninth Circuit's Precedent

The line drawn between protectable and unprotectable features has been established by the precedent of the Ninth Circuit (e.g. *Aliotti*) and by this Court in *Feist*. Quite clearly, the Ninth Circuit did not create a new legal standard, but rather followed the existing legal standard with respect to the copyright protection afforded subject matter composed of a combination of protectable and unprotectable elements. After stating the proper legal standard, it was proper for the Ninth Circuit to look at the record and identity the unprotectable elements. In this case, they consisted of expression resulting from the physiognomy of jellyfish and common elements of glass-in-glass art objects, including the use of clear glass and a common shroud shape, both of which are in the public domain available for all to use.

CONCLUSION

For the reasons set forth above, this Court is asked to deny Petitioner's petition.

Respectfully submitted,

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